

Remarks

This Application has been carefully reviewed in light of the final Office Action mailed April 23, 2003. Applicant believes all pending claims are allowable over the prior art of record. However, to expedite issuance of the Application, Applicant has amended Claims 1, 11, 20, and 29 to further clarify distinguishing features of Applicant's invention. At least the amendments adding "for the particular item" have not narrowed the claims, and none of the amendments are considered necessary for patentability. Applicant respectfully requests reconsideration and allowance of all pending claims.

Interview Summary

Carol Donahue, a Legal Assistant for Applicant's attorneys, conducted a telephonic interview with Examiner Naresh Vig on June 3, 2003. Pursuant to MPEP § 713.04 and as requested by the Examiner in the Interview Summary mailed June 10, 2003, Applicant submits this summary of the telephonic interview to record Applicant's understanding of the substance of the interview, concurring in substance with the Examiner's Interview Summary.

Carol Donahue called to inform the Examiner that there were some errors on pages 3, 5, and 6 of the final Office Action mailed on April 23, 2003 regarding the claim numbers referenced by the Examiner. Corrections were confirmed by Christopher W. Kennerly, Applicant's Attorney, via voice mail. The Examiner agreed to fax a copy of the corrections to Mr. Kennerly. The Examiner agreed to the following corrections:

- On page 2, line 11, 7-18 has been changed to 8-15;
- On page 5, paragraph 2, line 1, 22 has been changed to 21;
- On page 5, paragraph 3, line 1, 7 has been changed to 14 and 23 has been changed to 22-23; and
- On page 6, paragraph 6, line 1, 25 has been changed to 24-25.

Independent Claims 1, 11, and 20 are Allowable

The Examiner rejects Claims 1-6, 8-15 and 17-29 under 35 U.S.C. §103(a) as being unpatentable over Warranty Direct ("*WarrantyDirect*") in view of Lending Tree, Inc. ("*LendingTree*") and in further view of HomeGain.com ("*HomeGain*"). Applicant respectfully disagrees.

Independent Claim 1, as amended, recites:

A method for enabling a warranty transaction, comprising:
receiving a warranty request from a customer computer, the warranty request *specifying a particular item* that a customer desires to cover under a warranty, the warranty request *comprising an identification of the particular item* and desired characteristics of the warranty under which the particular item is to be covered;
accessing, *from one or more sources other than the warranty request*, one or more characteristics *of the particular item*;
generating, using a warranty generation engine, one or more warranty packages *for the particular item* consistent with the warranty request and according to one or more rules, each rule associating one or more item characteristics with one or more warranty characteristics;
communicating the generated warranty packages *for the particular item* to the customer computer;
receiving a selection of at least one warranty package *for the particular item* from the customer computer; and
communicating the selected warranty package *for the particular item* to one or more warranty provider computers.

Independent Claims 11, 20, and 29 recite substantially similar limitations. The proposed combination of *WarrantyDirect*, *LendingTree*, and *HomeGain* does not disclose, teach, or suggest these limitations, whether the combination is considered by itself or in further combination with any other reference of record or with knowledge of one skilled in the art at the time of invention.

For example, nothing in any of the cited references discloses, teaches, or suggests "receiving a warranty request from a customer computer, the warranty request *specifying a particular item* that a customer desires to cover under a warranty, the warranty request *comprising an identification of the particular item*." *WarrantyDirect*, for example, merely discloses submitting a request to receive a quote for a warranty. The request disclosed in *WarrantyDirect* may generically specify a *type* of car (e.g., generically, a make and model of a car). However, this is far different than a warranty request "*specifying a particular item*" and "*comprising an identification of the particular item*" as recited in Applicant's Claim 1.

Because the request in *WarrantyDirect* does not specify "*the particular item*" or comprise "*an identification of the particular item*," *WarrantyDirect* also necessarily fails to disclose, teach, or suggest "accessing, *from one or more sources other than the warranty*

request, one or more characteristics *of the particular item*" as recited in Claim 1. According to *WarrantyDirect*, a request may generically specify a *type* of car and may include certain information about a particular car that the customer wants to cover under warranty such as the mileage of the car. However, because the particular car is not specified or identified in the request, the only information available to *WarrantyDirect* about the particular car the customer wants to cover under a warranty is information provided by the customer in the request itself. This may be problematic for *WarrantyDirect*. For example, in providing certain information in the request, the customer may easily lie about certain information (e.g., the particular car's mileage) or fail to include certain information (e.g., that the particular car has been severely damaged in an accident) that may be important to *WarrantyDirect* in deciding whether to offer a warranty and, if so, on what terms. In contrast, because the warranty request recited in Applicant's Claim 1 specifies "*the particular item* that a customer desires to cover under a warranty" and comprises "*an identification of the particular item*," a warranty generation engine is capable of "*accessing, from one or more sources other than the warranty request, one or more characteristics of the particular item.*" Thus, using Applicant's claimed invention, the warranty generation engine may, in certain embodiments, be able to confirm certain information provided in a warranty request about the particular item or discover other information about the particular item "*from one or more sources other than the warranty request.*"

Thus, *WarrantyDirect* fails to disclose, teach, or suggest "receiving a warranty request from a customer, the warranty request *specifying a particular item* that a customer desires to cover under a warranty, the warranty request *comprising an identification of the particular item*," as recited in Claim 1. Neither *LendingTree*, *HomeGain*, nor any other cited reference makes up for these deficiencies of *WarrantyDirect*.

Additionally, the Examiner acknowledges that "*WarrantyDirect* does not disclose identification of a particular item." (Office Action, Page 4) The Examiner further states that "it is known at the time of [the] invention to a person with ordinary skill in the art that unique identifiers like Serial Numbers (S/N), Vehicle Identification Numbers (VIN) are used for identification purposes *to ensure that the product brought in for service is the actual product*

for which the customer purchased the warranty service." (Office Action, Page 4) (emphasis added)

First, to the extent that the Examiner maintains this rejection based on "Official Notice," "well-known art," "common knowledge," or other information within the Examiner's personal knowledge, Applicant respectfully requests that the Examiner cite a reference in support of this position or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.107.

Second, using a unique identifier such as a S/N or VIN "to ensure that the product brought in for service is the actual product for which the customer purchased the warranty service" occurs after, perhaps years after, the customer has purchased a warranty package. In contrast, the warranty request recited in Applicant's Claim 1 is directed toward subsequent generation of one or more warranty packages: "receiving a warranty request from a customer computer, *the warranty request specifying a particular item* that a customer desires to cover under a warranty, *the warranty request comprising an identification of the particular item* and desired characteristics of the warranty *under which the particular item is to be covered.*" The specification and identification of the particular item in the warranty request of Claim 1 is subsequently used, still prior to generation of the one or more warranty packages, in "*accessing, from one or more sources other than the warranty request, one or more characteristics of the particular item*" and then used in "generating, using the warranty generation engine, one or more warranty packages *for the particular item.*" Knowing the "particular item that a customer desires to cover under warranty" may be important in subsequently generating the one or more warranty packages, as illustrated in the examples discussed above. Thus, Applicant respectfully submits that it being "known at the time of [the] invention to a person with ordinary skill in the art that unique identifiers like Serial Numbers (S/N), Vehicle Identification Numbers (VIN) are used for identification purposes *to ensure that the product brought in for service is the actual product for which the customer purchased the warranty service,*" even if true, has no bearing on the patentability of Applicant's claimed invention. Furthermore, neither *LendingTree*, *HomeGain*, nor any other cited reference makes up for these acknowledged deficiencies of *WarrantyDirect*.

In addition, at least because *WarrantyDirect* fails to disclose, teach, or suggest a warranty request "specifying a particular item" and "comprising an identification of the particular item," *WarrantyDirect* also necessarily fails to disclose, teach, or suggest:

- generating, using a warranty generation engine, one or more warranty packages *for the particular item* consistent with the warranty request and according to one or more rules, each rule associating one or more item characteristics with one or more warranty characteristics;
- communicating the generated warranty packages *for the particular item* to the customer computer;
- receiving a selection of at least one warranty package *for the particular item* from the customer computer; and
- communicating the selected warranty package *for the particular item* to one or more warranty provider computers.

Neither *LendingTree*, *HomeGain*, nor any other reference makes up for these deficiencies of *WarrantyDirect*.

For at least the reasons given above, *WarrantyDirect* fails to disclose, teach, or suggest the limitations specifically recited in independent Claims 1, 11, 20, and 29, as amended, whether *WarrantyDirect* is considered alone, in combination with *LendingTree* and *HomeGain*, or in combination with any other reference of record or with knowledge of one skilled in the art at the time of the invention. Accordingly, Applicant respectfully requests reconsideration and allowance of independent Claims 1, 11, 20, and 29, together with all claims that depend on Claims 1, 11, 20, and 29.

Dependent Claims 2-6, 8-10, 12-15, 17-19, and 21-29 are allowable

Dependent Claims 2-6 and 8-10 (which depend from independent Claim 1), dependent Claims 12-15 and 17-19 (which depend from independent Claim 11), and dependent Claims 22-28 (which depend from independent Claim 21) are allowable at a minimum because of their dependency on independent Claims 1, 11, and 21, which Applicant has shown above to be allowable. In addition, dependent Claims 2-6, 8-10, 12-15, 17-19, and

21-28 recite further patentable distinctions over the prior art of record. To avoid burdening the record and in view of the clear allowability of Claims 1, 11, and 21, Applicant does not specifically discuss in this Response the further patentable distinctions recited in dependent Claims 2-6, 8-10, 12-15, 17-19. However, Applicant reserves the right to discuss these distinctions in a future Response if appropriate. Applicant respectfully requests reconsideration and allowance of dependent Claims 2-6, 8-10, 12-15, 17-19.

Conclusion

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicant, at the Examiner's convenience at (214) 953-6812.

Although no fees are believed to be due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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